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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/981,411	10/16/2001	George H. Kitchen III	70008-9101	5840

. 5179 7590 08/06/2003

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EXAMINER

MEDLEY, MARGARET B

ART UNIT PAPER NUMBER

1714

DATE MAILED: 08/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/981,411

Applicant(s)

KITCHEN ET AL.

Examiner

Margaret B. Medley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on July 03, 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 67-170 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 67-170 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 17.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

The Office action is in response to Paper No. 14 dated July 3, 2003

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 3, 2003 has been entered.

The amendment, Paper No. 13 dated July 3, 2003 amending the specification at page 7, canceling claims 1-66 and adding claims 67-170 has been entered of record.

The pending claims of record are claims 67-170.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The amendment filed January 31, 2002 and October 22, 2002 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention.

The added material, which is not supported by the original disclosure is as follows:

On page 1 in the paragraph beginning at line 8 in line 12 after "microbial growth" the insertion of the phrase ---and act as a strong demulsifier ...;---.

On page 8, in the paragraph beginning on line 19, line 21 change "0.03" to ---0.05---.

On page 9, in the paragraph beginning on line 12, line 13 changes "0.3 parts" to—0.03 parts--.

On page 9, the insertion of—0.005—and the insertion of—0.3--.

On page 12, in the paragraph beginning on line 6 the deletion in lines 8 and 9.

On page 13, at lines 15 and 20 the deletion of "462 patent: and insertion of ---prior art---; on page 14 at line 2 of paragraph 3 the deletion of "462 composition" and insertion of ---prior art sample---; and at line 7 of paragraph 3 of page 14 the deletion of "462" and insertion of ---prior art---.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim 103 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The "0.005 and approximately 0.150" limitation is considered as new matter because the said relative proportion was not found in the disclosure and claims as originally filed. Applicants did not point out to the examiner the specific location in the

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instant application of the said limitation and the examiner did not find the location of the said limitation.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claim 90 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The limitation "viscosity is approximately 20 weight or less" is indefinite because it is unclear as to the unit of measurement that is being referenced in claim 90.

Claims 162-170 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The limitation "a non-platinum organo-metallic compound" is considered as new matter because it contradicts the originally filed claims and the bridging paragraph at pages 6-7 of the instant application.

Claims 67-170 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The "iron-containing organo-metallic compound of claim 67 and the "a non-platinum metallic-metallic compound" of claim 162 is indefinite and confusing when

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viewed in light of the "comprising" language of line 1 requiring the present of at least two component. The examiner takes the position on record that the said limitation "said fuel additive is to be added to the fuel... 5,000 parts per volume of the fuel" is a future limitation directed to a fuel composition. Therefore, the said phrase will not be considered a limiting limitation for the fuel additive for the pending claims.

Claims 67 and 170 (and their pending claims) are indefinite and confusing because it is unclear from the specification and originally filed claims as to the units of measurement that is being used for the metallic-metallic compound being referenced. Clarification to the record is required.

Claims 91, 92, 96, 97 and 103 are indefinite and confusing because it is unclear from the specification and originally filed claims as to the metes and bounds for the unit of measurement that are being used for the said additive components. Clarification to the record is required.

Applicant's arguments with respect to claims 67-170 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments filed July 03, 2003 have been fully considered but they are not persuasive.

Contrary to applicant's statement in paragraph 3 on page 5 of Paper No. 5 dated October 22, 2002, the Examiner did not find any amendment to page 1 of the instant specification. Therefore the new matter rejection based on 35 USC 132 is maintained.

The amendment to page 9, at line 3 of paragraph 3, changing "0.3 parts" to ---- 0.03 parts---is considered as new matter and contradict the limitation at @0.05 and at

@0.15 of originally filed claim 38 and paragraph 3 in line 3 of page 9 in Paper No. 5 dated October 22, 2002. The amendment to page 9 in line 3 of paragraph 3 dated January 31, 2002 in Paper No. 2 is still considered as new matter. The examiner agrees with applicants' conclusion that the amended ranges fall within the broad ranges and preferred ranges as originally filed. However, the examiner fails to see applicant arbitrarily selection of the amended ranged and applicant has failed to point out the basis for arbitrarily selection of such ranges.

The amendment to page 8 in line 3 of the third full paragraph of Paper No. 5 dated October 22, 2002 changing "0.03" to—0.05—is considered as new matter. Applicant has not provided the basis for arbitrarily selecting the most preferably range as being the more preferably lower range. It is noted that an example containing a single value was held not to be sufficient to support a claimed range containing said value. In re Lukach 169 USPQ 795 (CCPA 1971). Therefore a most preferable range would not be held sufficient to support a range containing said value.

The examiner maintains the position that the deletion of lines 3-4 of paragraph 2 and the insertion at line 3 of paragraph 3 on page 3 of the instant application in Paper No. 2 dated January 31, 2002 constitute new matter. New matter includes deletions and omissions. See MPEP 706.03(0).

The insertion at line 1 of Table 2 on page 13 constitutes new matter because it is unclear from reading the instant specification if the Run values are based on percentage because the baseline value has not been established. The examiner's position is that

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the RPM values for the fuel economy is not the same testing as the particulate emission testing because different testing were conducted, note MPEP 706.03(0).

The deletion of the "462 patent"; "462" composition and "462" at various locations on pages 13 and 14 of the instant application is considered as new matter, note MPEP 706.03(0). Applicant reference to "462" is directed to a specific prior art, note page 2 first full paragraph of the instant application. The phrase "prior art" clearly does not make reference to any specific art, MPEP 706.03(0).

The claims have not been treated on the merits over the prior art because the metes and bounds for the unit of measurement for the additives have not been established.

The prior art cited but not applied further teaches fuel additives comprising metallic-metallic compounds, stabilizers, solvents, lubricant, dispersants, metal deactivators and biocides of the same nature as claimed by applicant.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret B. Medley whose telephone number is (703) 308-2518. The examiner can normally be reached on Monday--Friday from 7:30 a.m. to 6:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (703) 306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.



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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

M.B. Medley/dh  
August 5, 2003

  
MARGARET MEDLEY  
PRIMARY EXAMINER